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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/806,690	03/23/2004	Edward C. Villela	DN-2652-2/DIV	2435

7590

10/18/2005

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EXAMINER

DURAND, PAUL R

ART UNIT

PAPER NUMBER

3721

DATE MAILED: 10/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/806,690

Applicant(s)

VILLELA ET AL.

Examiner

Paul Durand

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 September 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 09/05.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 9/9/2005 has been entered.

### ***Information Disclosure Statement***

2. The information disclosure statement (IDS) submitted on 9/9/2005 was filed after the mailing date of the Notice of Allowance on 3/28/2005. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner. However, the cited prior art of the brochure does not have a specific document date, only the fax stamp of the document itself and the product launch date of early 2001. Applicant is requested to provide a specific prior art date for the cited brochure.

In addition, the photograph of the spacer also provided on the submitted IDS provides no prior art date, and does not appear to be part of the brochure, as it is listed as a separate item on the IDS. As a result, it has been deemed admitted prior art

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available more than 1 year prior to the filing date of the application under § 102(b) and is being used as basis for rejection under § 103(a).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (US 2,918,675) in view of the photograph of the nail spacer (no date provided)

In regard to claims 1 and 2, Smith discloses the invention substantially as claimed including a pneumatically operated nail gun comprised of driving cylinder 12, with an inlet, for feeding nails and outlet (generally by 88), trigger mechanism 41, a base portion (generally indicated as 64), with a depth control spacer 125, attached to the base portion, which can remain on the gun permanently (see Figs. 1,3,5 and C3,L13 C4,L44). What Smith does not disclose is the specific size and shape of the spacer. However the photographic literature teaches that it is old and well known in the art to provide a depth spacer which attaches to a nail gun prior to use, comprised of a distal end with a horizontal portion, a proximal end, center portion, a vertical side portion, extending from a horizontal portion, a second portion extending from the vertical side portion, a third side portion extending from the second side portion and forming an obtuse angle with the tip of the spacer and an oval center section having a longitudinal

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and transverse axis for the purpose of ensuring that a nail is only inserted to a certain depth (see photo of spacer).

Furthermore, while both Smith and the photograph are silent to the exact dimensions of the spacers, the examiner takes Official Notice that it is old and well known in the art to design a part with specific dimensions for the purpose of allowing the part to cleanly mate with an assembly. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the invention of Smith with the specifically sized and shaped spacer as taught by the spacer photograph for the purpose of allowing a spacer to cleanly mate with a tool and that a nail is only inserted to a certain depth.

In regard to claims 3-5, the modified invention of Smith discloses the invention substantially as claimed as applied to claim 1 above, except for the specific disclosure of the material used to manufacture the spacer. However, the examiner asserts that it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the invention of Smith with a material manufactured from metal or polymer compound, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

### ***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Durand whose telephone number is 571-272-4459.

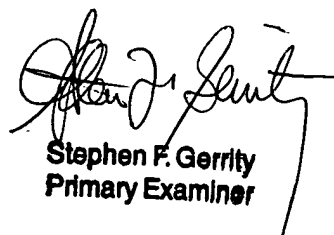
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The examiner can normally be reached on 0730-1800, Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I. Rada can be reached on 571-272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Paul Durand  
October 14, 2005



Stephen F. Gerrity  
Primary Examiner